

## REMARKS

This communication is a full and timely response to the Office Action dated October 16, 2009. Claims 1-11 and 13-22 remain pending. By this communication, claim 12 is canceled without prejudice or disclaimer of the underlying subject matter and claims 1 and 13 are amended. Support for the amended subject matter can be found, for example, in Figure 1 and at page 6, lines 17-21 of the disclosure.

In numbered paragraph 4 on page 2 of the Office Action, claims 1-22 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Marin-Pache* (U.S. Patent No. 6,506,990), and further in view of *Byers* (U.S. Patent No. 6,693,247). Applicant respectfully traverses this rejection.

Independent claim 1 recites the following:

An apparatus for actuating an electrical switching device high-voltage power breaker having at least one moving contact piece, the at least one moving contact piece being driven via a rotating shaft, wherein an electric motor having a rotating drive shaft, which can be coupled to the rotating shaft for the switching device by means of a gear mechanism, is provided for the purpose of driving the rotating shaft to switch the switching device high-voltage power breaker on and off,

wherein the first axis of the drive shaft runs parallel to the second axis of the rotating shaft in a common horizontal plane.

The combination of the *Marin-Pache* and *Byers* patents fails to disclose or suggest at least the foregoing features.

The *Marin-Pache* patent discloses an electrical switchgear apparatus having a drive mechanism 12 and three identical breaking modules 14, 16, 18. The drive mechanism 12 includes a pole shaft 32 that is connected to the three breaking modules 14, 16, 18 via a transmission rod 40. The transmission rod 40 is connected to respective double levers 70, 72, 74, which translate the force of rotation of the pole shaft to an associated breaking module 14, 16, 18. The *Marin-Pache* patent discloses that the kinematic system defines five geometric axes of parallel rotation.

However, based upon a reasonable and prudent reading of the reference, no two of the five geometric axes together establish a structure such as Applicant's claimed first axis of the drive shaft and second axis of the rotating shaft, wherein the first axis of the drive shaft runs parallel to the second axis of the rotating shaft in a common horizontal plane.

The Examiner concedes that the *Marin-Pache* patent fails to disclose or suggest a motor and a gear mechanism to drive the transmission device to switch the breaker on and off as recited in claim 1, and relies on the *Byers* patent in an effort to remedy this deficiency.

While not acquiescing to the Examiner's interpretation of the alleged teachings presented in the *Byers* patent, Applicant submits that this reference fails to disclose or suggest first and second axes of a drive shaft and rotating shaft, respectively, that are situated as recited in claim 1. More importantly, the *Marin-Pache* patent discloses a configuration that does not appear to be readily modifiable to include the configuration of drive shaft and rotating shaft axes as recited in Applicant's claims. Stated differently, based on the guidance provided in the *Marin-Pache* patent it appears that modifying this reference to include a structure in which the first axis of the drive shaft runs parallel to the second axis of the rotating shaft in a common horizontal plane, as recited in claim 1, would destroy the principle operation of the same. As such, even if these references were combinable as alleged, the proposed modification or combination of the *Marin-Pache* and *Byers* patents would change the principle of operation of the *Marin-Pache* invention being modified, such that the teachings of the references are not sufficient to render the

claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See also MPEP §2143.01, (8th ed. August 2001, Rev. July 2008).

In summary, the *Marin-Pache* and *Byers* patents when applied alone or in combination as alleged by the Examiner fail to disclose or suggest at least all of the features and/or the combination of features recited in Applicant's claims. For at least this reason, a *prima facie* case of obviousness has not been established.

The Office has the initial burden of establishing a **factual basis** to support the legal conclusion of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning with some rational underpinning** to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added). As a result of the above-described deficiencies in the applied art, claim 1 is believed to be distinguishable over the applied art such that withdrawal of the rejections under 35 U.S.C. §103 is deemed appropriate.

### **Conclusion**

Based on at least the foregoing amendments and remarks, Applicant submits that claims 1-11 and 13-22 are allowable, and this application is in condition for allowance. Applicant requests favorable examination and consideration of the instant application. In the event the instant application can be placed in even better form, Applicant requests that the undersigned attorney be contacted at the number listed below.

Respectfully submitted,

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